

REMARKS

The claims have been amended according to the marked up amendments above. No new matter is believed or intended to have been introduced by those amendments.

Applicants would like to express their appreciation for the courtesies extended by the Examiner during the telephonic interview of December 27, 2007 ("Interview"). While no agreement was reached during the Interview, the Applicants believe that the remarks and amendments set forth herein clearly distinguish the pending claims from the art of record for at least the reason that the art of record does not teach or suggest expert system processing which results in output of multiple alternative solutions.

Claim 1

Claim 1 has been amended to explicitly recite the step of presenting an output comprising a recommended solution, a compatible solution, and a not recommended solution. During the Interview, the Applicants submitted that U.S. 5,963,939 ("McCann"), the sole reference cited against the pending claims, taught presenting an output consisting of a single solution, and therefore that claims which require presenting an output comprising multiple solutions were not taught by McCann. In response, the Examiner referred the Applicants to the incremental editor of McCann (depicted in figure 51 of McCann), and asserted that the incremental editor taught presenting output comprising multiple solutions. While the Applicants appreciate the Examiner's straightforward explanation of the reasoning for believing that McCann teaches an output comprising multiple solutions, the Applicants respectfully traverse the Examiner's characterization of McCann, and assert that, properly understood, McCann does not teach or suggest output comprising multiple alternative solutions. As set forth below, properly understood, McCann does not teach or suggest providing output comprising multiple alternative solutions either expressly or inherently. In fact, McCann teaches away from providing such an output. Accordingly the rejections of the pending claims based on McCann should be withdrawn, and those claims should be allowed.

First, the Applicants submit that it is clear that McCann does not expressly teach presenting output comprising multiple alternative solutions. In McCann, software is used to

gather information about a user's computing requirements, then suggests a solution that meets or exceeds those requirements.¹ Once the system of McCann suggests a solution, the user is provided with a tool – the incremental editor – which can be used to customize the solution by substituting slightly higher or lower ranked products.² As shown below in the reproduction of figure 51 of McCann, the incremental editor allows the user to make small changes to a single recommended solution. It does not present multiple solutions, then let the user compare or choose between them.³

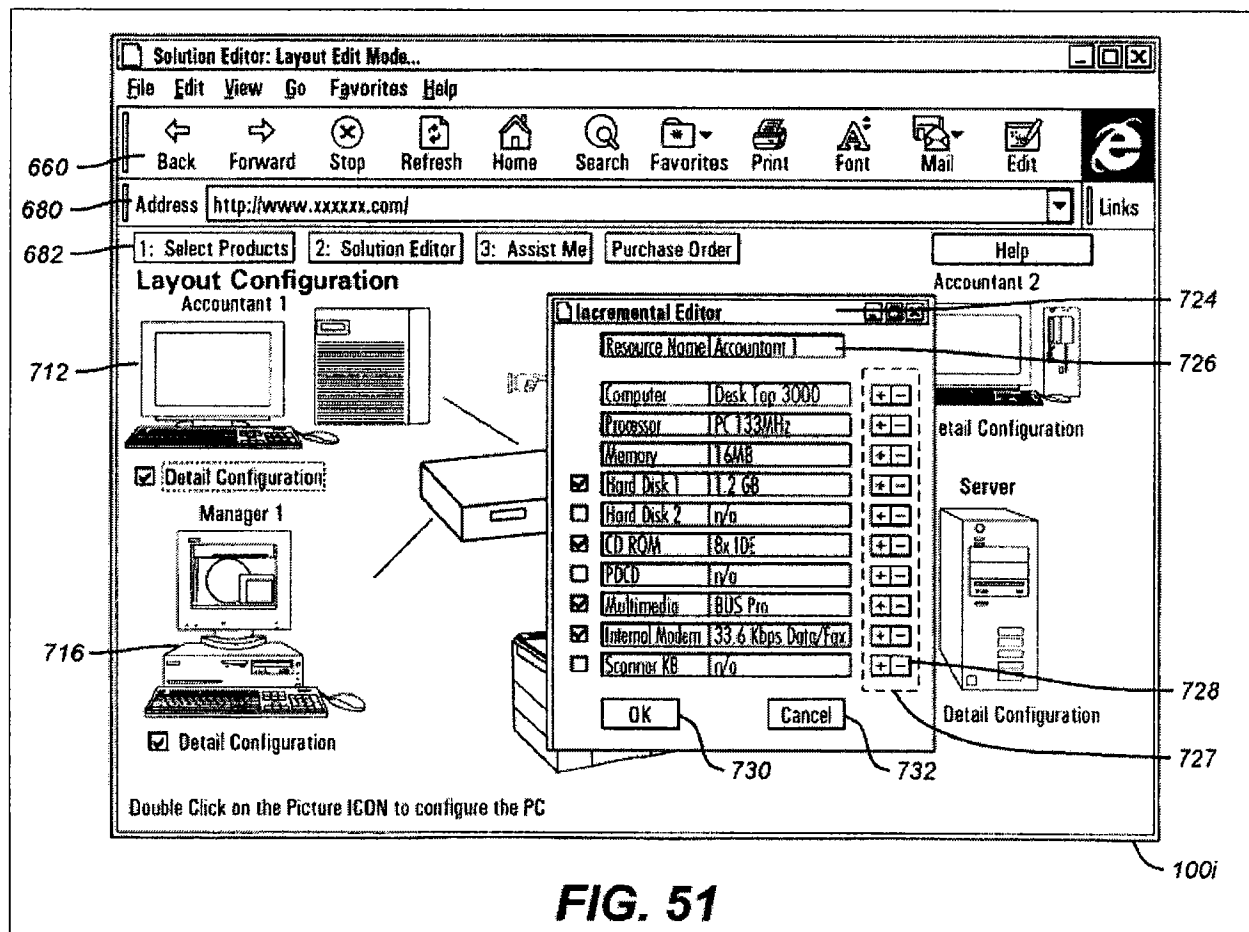


FIG. 51

McCann, figure 51. The user makes changes to the single recommended system using the +/- buttons on the right of the screen. The user is not presented multiple solutions to compare or choose between.

¹ McCann, col. 2, ll. 55-59.

² McCann, col. 4, ll. 30-32.

³ The Applicants note that McCann does teach that a solution might comprise multiple products (e.g., a server, a desktop, and a printer). While the Applicants do not concede that teaching a solution comprising multiple products teaches or suggests an output comprising multiple solutions, to help ensure that the pending claims are not improperly rejected over McCann, the Applicants have amended the claims to recite that the multiple solutions presented are *alternatives*, rather than components within a larger whole.

The disclosure of McCann is extremely clear that only a single solution is presented to the user. For example lines 52-62 of column 12 provide the following description of the relationship of the system and the user when deciding a solution:

The various phases of the tool converge on **a specific solution** from among the possible solutions. Once **a particular solution** is recommended, the user may choose to activate an incremental editor. The incremental editor is a set of processes that can be used to choose a different solution from among the possible solutions, and can also be used to change a response to a particular question. Thus, **a user** is free to develop new combinations of products, examine new network topologies, and expand and personalize the utility of the tool to develop new solutions to new products. (emphasis added)

As highlighted by the emphasized text, the software tool of McCann converges on one specific solution. That particular solution is then recommended. After that (one) solution is recommended, the user has the opportunity to modify it using the incremental editor. While this may result in the user choosing a different solution from the one recommended by the software, it does not teach presenting an output which comprises multiple solutions, where the output is itself generated by an expert system, as is recited in claim 1. Accordingly, McCann does not expressly disclose the presentation of output comprising multiple alternative solutions, where the output is generated by the expert system.

Those limitations are also not inherently present in McCann. During the Interview, the Examiner suggested that presenting multiple solutions might be inherent in the incremental editor, since the system would have to have generated multiple compatible solutions so that the user could choose between them. In response to that argument, the Applicants respectfully draw the Examiner's attention to the following points. First, even if the disclosure of an incremental editor did require pre-generation of multiple solutions, claim 1 recites presentation (not just generation) of multiple solutions and McCann is very clear that only one solution is presented to the user. Second, claim 1 has been amended to recite presenting output comprising a recommended solution, a compatible solution, and a not recommended solution.⁴ Even if the pregeneration argument were correct with respect to simply presenting a plurality of solutions, there is no reason why the system would generate solutions compatible and not recommended solutions, in addition to the recommended solution presented in the output. Accordingly,

⁴ Applicants assert that no new matter is added by this amendment, and that support can be found in at least lines 15-20 of page 28 of the application as originally filed.

McCann does not inherently disclose presenting output comprising a plurality of alternative solutions, as is currently recited in claim 1.

McCann also does not suggest presenting and output comprising a plurality of alternative solutions. When discussing the processing which takes place in recommending a solution, McCann addresses the possibility that there will be multiple solutions that could potentially be recommended to the user.⁵ In that case, rather than presenting multiple solutions (or even informing the user that multiple potential solutions exist), McCann teaches avoiding presenting multiple solutions by selecting from the potential solutions at random, then recommending that to the user.⁶ Accordingly, McCann cannot be read to suggest presenting an output comprising multiple solutions, because, in a situation where multiple solutions really are available, McCann explicitly discloses presenting only one. Indeed, McCann actually teaches away from presenting multiple solutions by teaching that, rather than presenting multiple solutions and letting the user choose from among them, it is preferable to recommend a single solution which is chosen *at random*.

In light of the above remarks, the Applicants submit that claim 1 cannot properly be rejected based on McCann. Claim 1 cannot be rejected as anticipated by McCann, because an anticipation rejection requires that each element in a claim be expressly or inherently taught in a single reference, and McCann does not expressly or inherently teach presenting an output comprising a plurality of alternative solutions. Claim 1 cannot be rejected as obvious over McCann, because there is no suggestion in McCann to present output comprising a plurality of alternative solutions, and because McCann actually teaches away from presenting such output. Accordingly, as claim 1 is not obvious or anticipated by McCann, and McCann was the only art cited in the Office Action, the rejection of claim 1 should be withdrawn, and that claim should be allowed.

⁵ McCann, col. 63, ll. 56-66.

⁶ McCann, col. 63, l. 7 – col. 64, l. 8 (“In either case, several possible recommendations are equivalent, and the exemplary embodiment of the present invention must find a different way of determining the appropriate output. In the complete absence of any distinguishing criteria, the exemplary embodiment of **the present invention selects randomly** from the among the products and inter-networking topologies that equally and best meet the stated criteria of the user.”) (emphasis added).

Claims 2-8, 66 and 67

Applicants note that each of claims 2-8, 66 and 67 depends, either directly or indirectly, from claim 1. Consequently, each of those claims incorporates the novel limitations of claim 1. Therefore, for at least the reasons set forth above regarding claim 1, applicants respectfully request that the rejections of claims 2-8, 66 and 67 based on McCann be withdrawn.

Claim 41

The Applicants note that the second from last clause of claim 41 recites that “the expert system generates output comprising a recommended telecommunications solution and a compatible telecommunications solution and presents the output to the live human agent via the graphical user interface.” Upon examination, the Applicants submit that the sections of McCann the Office Action cited as teaching that aspect of claim 41, lines 24-30 of column 4, and figures 50 and 51, neither teach nor suggest the presentation of output comprising multiple alternative solutions. Regarding lines 24-30 of column 4, the Applicants note that, while that section teaches that “each product known to the tool is assigned a rank,” simply teaching that products are assigned ranks does not imply that multiple solutions are presented as output. Instead, McCann makes clear that those ranks are used for the system’s *internal* processing,⁷ and that only a single solution is presented to the user.⁸ Referring to figure 50, that figure “shows a visual graphic display of *a* recommended solution,”⁹ and does not teach or suggest presenting a *plurality* of solutions. Figure 51 depicts the incremental editor which, as discussed above, does not teach or suggest the presentation of output comprising a plurality of solutions. Accordingly, because none of the sections cited in the Office Action teach or suggest presenting output comprising a plurality of solutions, and because, as set forth above regarding claim 1, McCann cannot be used to reject a claim which recites presenting a plurality of solutions, the Applicants request that the rejection of claim 41 be withdrawn, and that that claim be allowed.

⁷ E.g., McCann, col. 20, ll. 51-55 (“At one stage, during Phase II (also described below), the Solutions Framework Base Class 400 extensions contain ranking information, identifying the product corresponding to the extension by category, rank and property.”).

⁸ Specifically referring to phase II where the use of rankings was described above, ll. 24-25 of col. 50 of McCann states that “[a]t the end of Phase II, *a single product* has been selected to comply with the requirements and guidelines” (emphasis added).

⁹ McCann, col. 5, ll. 53-54 (emphasis added).

Claims 42 – 45

Applicants note that each of claims 42-45 depends from claim 41. Consequently, each of those claims incorporates the novel limitations of claim 41. Therefore, for at least the reasons set forth regarding claim 41, applicants respectfully request that the rejections of claims 42-45 based on McCann be withdrawn.

Claim 46

The applicants note that claim 46 has been amended so that the last clause of that claim now recites “a set of instructions executed by the processing circuitry that presents an output to the live human agent, said output comprising a recommended solution, and a not-recommended solution, wherein the recommended solution and the not-recommended solution comprise alternative products selected from the plurality of available products.” As set forth above regarding claims 1 and 41, McCann cannot properly be used as the basis for rejecting any claim which recites presenting an output comprising multiple alternative solutions. Accordingly, the rejection of claim 46 should be withdrawn, and that claim should be allowed in its present form.

Claim 51

The Applicants note that the second from last clause of claim 51 recites “a set of instructions executed by the processing circuitry that generates output comprising a recommended solution and a compatible solution and presents the output to the live human agent via the graphical user interface.” Upon examination, the Applicants submit that the sections of McCann the Office Action cited as teaching that aspect of claim 51, lines 18-22 and 30-46 of column 3, and lines 24-30 of column 4 neither teach nor suggest the presentation of output comprising multiple alternative solutions. Regarding lines 18-22 of column 3, the Applicants submit that while that passage teaches that the tool described in McCann may have multiple modes (a novice mode and an expert mode),. However, the disclosure that a tool includes multiple modes does not imply that any of those modes presents output comprising multiple alternative solutions. Indeed, given the teachings of the sections of McCann discussed above with respect to claim 1, the Applicants submit that neither the novice nor the expert mode described in McCann teaches or suggests presenting output comprising multiple alternative solutions. Regarding lines 30-46 of column 3 of McCann, the Applicants note that those lines teach only the use of the incremental editor. However, as set forth above, the use of an

incremental editor does not teach or suggest the presentation of multiple alternative solutions. Accordingly, because the passages cited in the Office Action do not teach or suggest presenting output comprising multiple alternative solutions, and because, as set forth above, McCann cannot properly be used to reject a claim which requires presenting output comprising multiple alternative solutions, the rejection of claim 51 should be withdrawn, and that claim should be allowed in its present form.

Claim 68

The Applicants note that claim 68 has been amended to recite producing at least three product solutions, and presenting those at least three product solutions to a live human agent, where the presenting is done by a computer system. As set forth above, McCann does not teach or suggest the presentation of multiple alternative solutions to a human agent by an automated system. Accordingly, for the reasons set forth above, the rejection of claim 68 should be withdrawn, and that claim should be allowed in its current form.

Claims 69 – 82

Applicants note that each of claims 69-82 depends from claim 68. Consequently, each of those claims incorporates the novel limitations of claim 68. Therefore, for at least the reasons set forth regarding claim 68, applicants respectfully request that the rejections of claims 69-82 based on McCann be withdrawn.

Additional Amendments

The Applicants note that certain additional amendments have been made to the dependent claims so that those claims will conform to the independent claims in light of the amendments made and discussed herein. No new matter is believed or intended to have been introduced by those amendments, support for which can be found in at least the claims as originally filed, and the relevant independent claims.

Conclusion

Applicants submit that the above discussion does not constitute an exhaustive list of the novel limitations found in the pending claims which are not taught or suggested in the prior art of record. To the extent that applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Indeed, Applicants reserve all rights with respect to arguments not explicitly raised herein. Further, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicants traverse the rejections and preserve all rights and arguments.

In light of the arguments made herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. § 102(e). Accordingly, reconsideration and allowance of these claims are earnestly solicited. Applicants encourage the Examiner to contact their representative, William Morriss at (513) 651-6915 or wmorriss@fbtlaw.com, if questions persist or if additional matters need to be dealt with prior to allowance.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

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